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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,003	11/24/2003	Gregory E. Ross	150449D1	3969
38598	7590	07/14/2008		
ANDREWS KURTH LLP 1350 I STREET, N.W. SUITE 1100 WASHINGTON, DC 20005			EXAMINER XU, LING X	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 07/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,003

Applicant(s)

ROSS, GREGORY E.

Examiner

Ling Xu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-34 is/are pending in the application.
- 4a) Of the above claim(s) 23-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Claims 30-34 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The error relied upon to support the reissue application is not sufficient. Note MPEP 1414, section II, which states that the error must specifically be identified. It is sufficient that the reissue oath identify a single word, phrase or expression in the claim and how it renders the original patent inoperative or invalid. While applicant states that he filed reissue application 09/706,491 with claims that were broader in scope than the claims issued in US Patent 5,830,529, and that applicant cancelled claims 36-46 and 48 from the parent reissue and presented these claims in the present divisional reissue, applicant does not identify a single word, phrase or expression in the pending claims 23-34, specifically, in the elected claims 30-34.

The nature of the defect(s) in the oath is set forth in the discussion above in this Office action.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 30-34 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hill (US 4,673,609).

As stated in the prior Office action, regarding claim 30, Hill discloses a unidirectional panel comprised of panel of transparent (substrate) material having a first design visible from one side yet not the other, (column 2, lines 23-30). The design (second coating) on the panel is superimposed on a pattern of opaque elements (first coating), (column 3, lines 10-33).

Hill also discloses that vision can be obtained in either direction through the panel without any perception of any design or color of silhouette pattern, when the level of illumination perceived through the panel from the far side of the panel is much greater than the illumination reflected from the near side of the panel. In addition, it is a feature of the panels of the disclosed invention that the design and/or silhouette pattern becomes less perceptible from the side of the panel from which the design and/or silhouette pattern is normally visible as the level of illumination transmitted through the panel from the other side increases (col. 2, lines 60-65), which indicates that the design (the second coating) changes as a function of intensity of ambient visible light, as recited in claim 30.

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In addition, the panel of FIG. 2 has a regular pattern of dark ink 26 on one side of the sheet 10 and is superimposed by light colored or light reflective ink 25. When viewed from the front (that is from the right as illustrated in FIG. 2) the light colored pattern 25 has the effect of inhibiting vision through the panel. From the other side, however, the less reflective dark colored pattern 26 does not prevent vision through the panel. This one way effect is further enhanced if the level of illumination on the front of the panel is greater than at the rear (col. 6, lines 55-67), which is another example that the design (the second coating) changes as a function of intensity of ambient visible light, as recited in claim 30.

Regarding claims 31-34, the panels can be used on vehicles (motor vehicles), (column 21, lines 49-67), meeting the limitations of claim 31. The pattern of the panel can be in the form of indicia, (column 22, lines 52-60), meeting the limitations of claim 32. The design portion of the panel can have two or more colored areas, (column 14, lines 38-50), meeting the limitations of claim 33. The panel can be attached to a vehicle windshield, (column 15, lines 11-24), meeting the limitations of claim 34.

Response to Arguments

3. Applicant's arguments filed on 11/19/2008 have been fully considered but they are not persuasive.

Applicant argues that Hill does not disclose, explicitly or impliedly, "a second coating formed on at least a portion of said substrate comprising a pattern that changes as a function of intensity of ambient visible light," as recited in claim 30.

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As stated in the above Office action, Hill discloses the design and/or silhouette pattern becomes less perceptible from the side of the panel from which the design and/or silhouette pattern is normally visible as the level of illumination transmitted through the panel from the other side increases (col. 2, lines 60-65), which indicates that the design (the second coating) changes as a function of intensity of ambient visible light, as recited in claim 30.

Hill also discloses that the panel of FIG. 2 has a regular pattern of dark ink 26 on one side of the sheet 10 and is superimposed by light colored or light reflective ink 25. When viewed from the front (that is from the right as illustrated in FIG. 2) the light colored pattern 25 has the effect of inhibiting vision through the panel. From the other side, however, the less reflective dark colored pattern 26 does not prevent vision through the panel. This one way effect is further enhanced if the level of illumination on the front of the panel is greater than at the rear (col. 6, lines 55-67), which is another example that the design (the second coating) changes as a function of intensity of ambient visible light, as recited in claim 30.

Accordingly, Hill meets all the limitations of claims 30 and its dependent claims 31-34.

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling Xu whose telephone number is 571-272-7414. The examiner can normally be reached on 8:00 am- 4:30 pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ling Xu
Primary Examiner
Art Unit 1794

/Ling Xu/
Primary Examiner, Art Unit 1794

Lx
July 10, 2008